UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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2193	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>1/16/04</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-45</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-45</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>22 October 2003</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>1/16/04</u>.

4)☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Claims 1 – 45 have been examined.

Information Disclosure Statement

1.   The Information Disclosure Statement filed January 16, 2004 has been considered.

Claim Rejections - 35 USC § 101

2.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

3.   Claims 1 – 20 and 30 – 45 are rejected under 35 U.S.C. 101 because the claimed

invention is directed to non-statutory subject matter. The current focus of the Patent Office in

regard to statutory inventions under 35 U.S.C. § 101 for method claims and claims that recite a

judicial exception (software) is that the claimed invention recite a practical application. Practical

application can be provided by a physical transformation or a tangible result. No physical

transformation is recited and additionally, the final result of the claim is installing software

which is not a tangible because the result is not clearly and concisely claimed to be tangibly

embodied on a computer readable medium. The following link on the World Wide Web is for

the United States Patent And Trademark Office (USPTO) policy on 35 U.S.C. §101.

     <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/guidelines101_20051026.pdf>

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this
> or a foreign country, before the invention thereof by the applicant for a patent.

5.   Claims 1 , 4, 6 – 10, 21 – 24, 32 – 33 and 40 – 41 are rejected under 35 U.S.C. 102(a) as

being anticipated by Norris et al, filed December 28, 2000.

Claim 1

Norris anticipates a machine readable medium containing executable computer program instructions which when executed by a data processing system cause said system to perform a method to set up software installed on a storage device of the data processing system, the method comprising: automatically searching in a plurality of locations for configuration information (Norris, Abstract, search a preferred at an endpoint and having second or third party provider as option); and setting up the software installed on the storage device of the data processing system using first configuration information found in at least one of the plurality of locations (Norris, Abstract, two endpoints to attempt to get a codec).

Note

Updating the codec is a software update.

Claim 4

The medium of claim 1, wherein the plurality of locations comprise one default location on a storage device attached fixedly and locally to the data processing system. As per claim 1 – address to internet and map where to install.

Claim 6

The medium of claim 4, wherein the plurality of locations further comprise a remote location accessible to the data processing system through a network connection. As per claim 1 - Internet

Claim 7

The medium of claim 1, wherein the software is a portion of an operating system of the data processing system.

Examiner Interpretation

In view of the current limitations the limitation that the invention retrieves "a portion of an operating system" is given no patentable weight. No function is provided. The data could be any series of zeros and ones.

Claim 8

The medium of claim 1, further comprising: determining a plurality of identifications of the data processing system; wherein said searching uses the plurality of identifications to find configuration information suitable for the data processing system. As per claim 1 search more than one location for the codec.

Claim 9

The medium of claim 8, wherein the plurality of identifications comprise one of:
a) a network address of the data processing system; (Norris, Internet web address to access codec as per claim 1)
 b) a hostname of the data processing system; c) a hardware serial number of the data processing system; and d) a hardware address of a network interface device of the data processing system.

Claim 10

The medium of claim 8, wherein the plurality of identifications comprise one identification that matches any data processing system. As per claim 9.

Claim 21
A method to set up software installed on a storage device of a data processing system, the method comprising: automatically searching in a plurality of locations for configuration information; and setting up the software installed on the storage device of the data processing system using first configuration information found in at least one of the plurality of locations. As per claim1

Claim 22
The method of claim 21, wherein the software is a portion of an operating system of the data processing system. As per claim 7.

Claim 23
The method of claim 21, wherein the plurality of locations are periodically searched. As per claim 1 – Periodically is from time to time.

Claim 24
The method of claim 21, wherein the plurality of locations comprise one default location on a storage device attached fixedly and locally to the data processing system. Norris, Abstract, default used when preferred not able to be obtained.

Claim 32
A data processing system to set up software installed on a storage device of the data processing system, the data processing system comprising: means for automatically searching in a plurality of locations for configuration information; and means for setting up the software installed on the storage device of the data processing system using first configuration information found in at least one of the plurality of locations. As per claim 1.

Claim 33
The data processing system of claim 32, wherein the software is a portion of an operating system of the data processing system. As per claim 7.

Claim 40
A data processing system, comprising: memory including a storage device, the storage device having installed software; a processor coupled to the memory, the processor automatically searching in a plurality of locations for configuration information, the processor setting up the software installed on the storage device using first configuration information found in at least one of the plurality of locations. As per claim 1.

Claim 41
The data processing system of claim 40, wherein the software is a portion of an operating system of the data processing system. As per claim 7.

Claim Rejections - 35 USC § 103

6.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7.   Claims 2,3, 5, 11 – 20, 25, - 31, 34 – 39, 42 - 45 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Norris (as per above) in view of #6,807,558 B1 Hassett et al, Filed June

2, 1998.

Motivation to Combine

Norris teaches searching more than one location for software to install and Hassett teaches

security features of data transportation. therefore, it would have been obvious to one of ordinary

skill in the art at the time of invention to combine Norris and Hasset because security measures

makes computing environments more trustworthy.

Claim 2
The medium of claim 1, wherein the first configuration information comprises: a decryption key; and encrypted configuration information decrypt able with the decryption key. Hasset, col 30, lines 40 – 42, teaches encryption.

Claim 3
The medium of claim 2, wherein the decryption key and the encrypted configuration information are found in different locations of the plurality of locations. As per claim 2.

Claim 5
The medium of claim 4, wherein the plurality of locations further comprise one location in a removable medium locally attached to the data processing system. As per claim 1 – address to internet and map where to install.

Claim 11

A machine readable medium containing executable computer program instructions which when executed by a data processing system cause said system to perform a method to set up software for the data processing system, the method comprising: querying a directory server to obtain configuration information; and setting up the software for the data processing system using the configuration information obtained from the directory server. As per claim 1 and Hassett, Figure 4.

Claim 12
The medium of claim 11, wherein the software is a portion of an operating system of the data processing system. As per claim 9

Claim 13
The medium of claim 12, further comprising: automatically obtaining a network address and an address of the directory server from a server on a local area network; and configuring a network interface device of the data processing system to use the network address; wherein said querying uses the address of the directory server and the network interface device which is configured to use the network address. AS per claim 11.

Claim 14
The medium of claim 12, wherein the configuration information comprises one of:
a) user account information; (Hassett, Figure 4)
b) time zone information;
c) keyboard information; and
d) a default language.

Claim 15
The medium of claim 12, wherein the configuration information comprises information specifying whether one or more services of the operating system shall be provided on the data processing system. Hassett, Figure 20 Authentication – requires OS services.

Claim 16
The medium of claim 11, wherein the configuration information comprises a license key for the software. Norris, Abstract.

Claim 17
A machine readable medium containing executable computer program instructions which when executed by a data processing system cause said system to perform a method to set up software installed on the data processing system, the method comprising: automatically searching for encrypted configuration information; determining a decryption key to decrypt the encrypted configuration information; and setting up the software installed on the data processing system using the decryption key and the encrypted configuration information. As per claims 1 and 2

Claim 18

The medium of claim 17, wherein the decryption key is communicated from a remote data processing system to the data processing system, and the decryption key is not stored on a file system of the data processing system. As per claim 3

Claim 19
The medium of claim 17, wherein said determining the decryption key comprises searching in a plurality of locations. As per claim 3

Claim 20
The medium of claim 19, wherein the plurality of locations comprise one of:
a) a removable storage device locally attached to the data processing system;
b) a predetermined location in a file volume in a file system of the data processing system; and
c) a database on a remote data processing system accessible to the data processing system through a network connection. As per claim 6

Claim 25
The method of claim 24, wherein the plurality of locations further comprise one of: location in a removable medium locally attached to the data processing system; and a directory server. As per claim 5.

Claim 26
A method to set up software for a data processing system, the method comprising: querying a directory server to obtain configuration information; and setting up the software for the data processing system using the configuration information obtained from the directory server.
As per claim 11.

Claim 27
The method of claim 26, wherein the software is a portion of an operating system of the data processing system. As per claim 7.

Claim 28
The method of claim 27, further comprising: automatically obtaining a network address and an address of the directory server from a server on a local area network; and configuring a network interface device of the data processing system to use the network address; wherein said querying uses the address of the directory server and the network interface device which is configured to use the network address. As per claim 8.

Claim 29
The method of claim 27, wherein the configuration information comprises information specifying whether one or more services of the operating system shall be provided on the data processing system. As per claim 15.

Claim 30

A method to set up software installed on a data processing system, the method comprising: automatically searching for encrypted configuration information; determining a decryption key to decrypt the encrypted configuration information; and setting up the software installed on the data processing system using the decryption key and the encrypted configuration information. As per claims 1 and 2.

Claim 31
The method of claim 30, wherein said determining the decryption key comprises searching in a plurality of locations. As per claim 3.

Claim 34
A data processing system to set up software, the data processing system comprising: means for querying a directory server to obtain configuration information; and means for setting up the software for the data processing system using the configuration information obtained from the directory server. As per claim 26.

Claim 35
The data processing system of claim 34, wherein the software is a portion of an operating system of the data processing system. As per claim 7.

Claim 36
The data processing system of claim 35, further comprising: means for automatically obtaining a network address and an address of the directory server from a server on a local area network; and means for configuring a network interface device of the data processing system to use the network address; wherein said means for querying uses the address of the directory server and the network. interface device which is configured to use the network address. As per claim 13.

Claim 37
The data processing system of claim 35, wherein the configuration information comprises information specifying whether one or more services of the operating system shall be provided on the data processing system, and the one or more services comprise one of: a) email; b) printer; c) firewall; d) web; e) password; f) multimedia stream; and g) file sharing.
Norris, Internet – web, Abstract.

Claim 38
A data processing system to set up software, the data processing system comprising: means for automatically searching for encrypted configuration information; means for determining a decryption key to decrypt the encrypted configuration information; and means for setting up the software installed on the data processing system using the decryption key and the encrypted configuration information. As per claim 26.

Claim 39
The data processing system of claim 38, wherein the decryption key is communicated from a remote data processing system to the data processing system.

As per claim 2.

Claim 42
A data processing system, comprising: memory storing software; a network interface device; a processor coupled to the memory and the network interface device, the processor querying a directory server using the network interface to obtain configuration information, the processor setting up the software stored in the memory using the configuration information obtained from the directory server. As per claim 11.

Claim 43
The data processing system of claim 42, wherein the software is a portion of an operating system of the data processing system. As per claim 7.

Claim 44
A data processing system, comprising: memory storing software; a processor coupled to the memory, the processor automatically searching for encrypted configuration information, the processor determining a decryption key to decrypt the encrypted configuration information, the processor setting up the software installed on the memory using the decryption key and the encrypted configuration information. As per claim 26

Claim 45
The data processing system of claim 44, wherein the processor searches in a plurality of locations to determine the decryption key, and the plurality of locations comprise one of:
a) a removable storage device locally attached to the data processing system;
b) a predetermined location in a file volume in a file system of the data processing system; and
c) a database on a remote data processing system accessible to the data processing system through a network connection. As per claim 3.
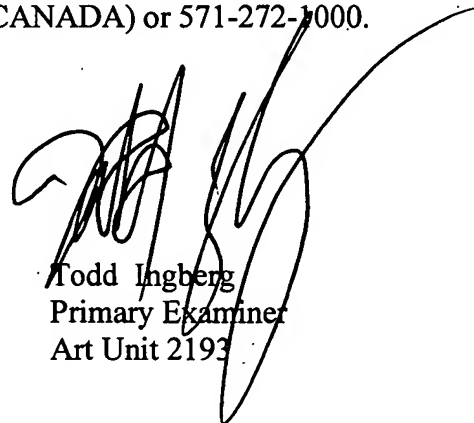

Correspondence Information

8.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Todd Ingberg whose telephone number is (571) 272-3723. The

examiner can normally be reached on during the work week..

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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TI